

REMARKS

Applicants appreciate the Examiner's thorough review of the present application, and respectfully request reconsideration in light of the preceding amendments and the following remarks.

Claims 1-20 are pending in the application. Claim 3 has been rewritten in independent form including all limitations of original claim 1. Claims 1 and 2 have been amended to better define the claimed invention. Claims 4-20 have been added to provide Applicants with the scope of protection to which they are believed entitled. No new matter has been introduced through the foregoing amendments.

The 35 U.S.C. 112, *second paragraph* rejection of claims 1-3 is believed overcome in view of the above amendments.

The 35 U.S.C. 103(a) rejection of claims 1-3 as being obvious over *Ryan* (U.S. Patent No. 4,326,528) in view of *Schmidt* (U.S. Patent No. 5,380,094) is noted. Applicants respectfully traverse, at least, the rejection of claim 3.

With respect to claim 3, the Examiner, relying on *In re Aller*, argued that the claimed compressive force would have been discoverable, to ensure ease of product withdrawal, using only routine skill in the art, because the general conditions of the claim are disclosed in the prior art. See the second full paragraph on page 4 of the Office Action.

The Examiner's reliance on *In re Aller* is misplaced. It should be noted that while *In re Aller* still remains good law, there are numerous exceptions to this rule e.g. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977) discussed in *MPEP* section 2144.05. II. B. The court in *In re Antonie* stated that "a particular parameter must first be recognized as a **result-effective variable**, i.e., a variable which achieves a recognized result, before the determination of the optimum or

workable ranges of said variable might be characterized as routine experimentation.” *Id* (emphasis added). In this particular case, application of *In re Aller* might be proper only if the art, prior to the present invention, has recognized the claimed compressive force as a result-effective variable. The Examiner has produced no evidence to prove this point.

It should be noted that *Ryan* teaches only elastic forces of the absorbent material of an individual diaper. See, e.g., column 3, lines 20-40 of *Ryan*. The reference does not teach a compressive force with which the diapers are packed. Apparently, *Ryan* has not recognized such compressive force as a result-effective variable. The reference is also silent on how to facilitate diaper withdrawal.

*Schmidt* only teaches tearing forces needed to tear the diaper bag. See, e.g., column 6, lines 50-55 of *Schmidt*. The reference does mention a compressive force, however, not as a result-effective variable. See, e.g., column 4, lines 7-16 of *Schmidt*. Instead, it is the direction/configuration of weakened line 5 that can be considered a result-effective variable. The reference is also silent on how to facilitate diaper withdrawal.

*Muckenfuhs* (U.S. Patent No. 5,054,619) additionally cited in the rejection of claim 3 does teach utilizing a compressive force to permit easy one at a time removal of diapers from the bag. However, the reference has not recognized such compressive force as a result-effective variable. It appears that any compressive force would work in the *Muckenfuhs* diaper bag, because as soon as the aperture 20 is torn open (FIG. 2), any compressive force in the bag will cause the unrestrained portion of the compressed diapers housed within the bag to partially project for easy withdrawal. See FIG. 2 and column 2, lines 59-64 of *Muckenfuhs*. Thus, a person of ordinary skill in the art would not have optimized the compressive force based on the *Muckenfuhs* teachings. The person of ordinary skill in the art would have, at best, optimized the size and shape of the weakened line if easy diaper withdrawal is a desirable property.

Accordingly, Applicants respectfully submit that none of the cited references have recognized the compressive force with which the diapers are packed as a result-effective variable. Therefore, it would not have been obvious to discover the claimed compressive force using only routine skill as the Examiner argued. The obviousness rejection of claim 3 is thus improper and should be withdrawn or at least rephrased.

Independent claim 1 has been amended to define over the applied references, especially *Ryan*. In particular, amended claim 1 now recites folding lines each **intersecting** with an edge of one of the leg holes. *See* folding lines 26a, 26b and the leg hole edges in FIG. 4 as well as page 9, lines 9-11 of the specification. In contrast, as can be seen in all figures of *Ryan*, folding lines 10/16 do not intersect with the leg opening edges; the *Ryan* folding lines and leg opening edges are basically parallel.

Accordingly, Applicants respectfully submit that amended claim 1 is patentable over the applied references.

Claims 2 and 4-11 depend from claim 1, and are considered patentable at least for the reason advanced with respect to amended claim 1. Claims 2 and 4-11 are also patentable on their own merits since these claims recite other features of the invention neither disclosed, taught nor suggested by the applied art.

For example, as to claim 4, the applied references do not fairly teach or suggest that each of the diapers is folded compactly and flatly to have a **generally uniform thickness** as seen in the direction of the row. *See* page 11, lines 4-8 of the specification. *Ryan* does not disclose or suggest such diapers. *See* FIGs. 1, 4, and 7 of *Ryan*.

As to claim 6, the applied references do not fairly teach or suggest that each of the folded diapers has **an outer contour defined by** an edge of the waist hole, the folding lines, a bottom line of the crotch region, and **parts of the edges of the leg holes**, and wherein each of the parts of the

edges of the leg holes extend between the respective folding line and the bottom line of the crotch region. See FIG. 3 of the instant application. In *Ryan*, the outer contour of each folded diaper is defined solely by the folding line, e.g., 10c in FIG. 4, and the bottom 10a of the crotch region. The leg hole edges are folded inwardly of the *Ryan* diaper and do not form part of the outer contour.

As to claims 7-8, the applied references do not fairly teach or suggest that, in each of the folded diapers, the edge of each of the leg holes has an **exposed part**. See FIGs. 1, 4 and 7 of *Ryan*.

As to claim 9, the applied references do not fairly teach or suggest that each of the folded diapers is a **pants-type diaper** having the transversely opposite lateral portions of the front and rear waist regions being **permanently** attached to each other. The diapers of *Ryan* are not of the pants type. See FIGs. 2, 5, and 8 of *Ryan*.

As to claim 10, the applied references do not fairly teach or suggest that the bag has a box shape comprising a top wall, a bottom wall and four side walls connecting the top and bottom walls, the bag further comprising a handle at the top wall, the **handle** being made integrally with and from the same material as the top, bottom, and side walls. See all figures of *Schmidt*.

As to claim 11, the applied references do not fairly teach or suggest the claimed compressive force. See the discussion *supra* with respect to claim 3.

New independent claim 12 is patentable over the applied references, because the references do not disclose, teach or suggest a package of disposable diapers, comprising a flexible bag and a plurality of folded disposable diapers compressively packed within the bag; wherein each of the diapers includes front and rear waist regions and a crotch region extending between the front and rear waist regions, transversely opposite left and right lateral portions of the front waist region being attached to transversely opposite left and right lateral portions of the rear waist region, respectively, to form a waist hole, a left leg hole, and a right leg hole, the attached left lateral portions of the front

and rear waist regions being folded along a left folding line and tucked inwardly of the diaper, the attached right lateral portions of the front and rear waist regions being folded along a right folding line and tucked inwardly of the diaper to **overlap** the folded and inwardly tucked left lateral portions of the front and rear waist regions. In other words, new claim 12 requires folded lateral portions which overlap each other. *See* FIG. 5 of the instant application. *Ryan* does not appear to teach or suggest this unique feature. *See* all figures of *Ryan*.

Claims 13-20 depend from claim 12, and are considered patentable at least for the reason advanced with respect to claim 12. Claims 13-20 are also patentable on their own merits since these claims recite other features of the invention neither disclosed, taught nor suggested by the applied art.

For example, as to claims 14-15 note the discussion *supra* with respect to claims 3-4, respectively.

As to claim 16, the applied references do not fairly teach or suggest that each of the folding lines is a straight line **closer** to a central longitudinal axis of the diaper than a bonding region where the respective lateral portions of the front and rear waist regions are attached. *See* FIG. 6 of the instant application. *Ryan* does not appear to teach or suggest this unique feature. *See* all figures of *Ryan*.

As to claims 19-20, note the discussions *supra* with respect to claims 9-10, respectively.

Each of the Examiner's rejections has been traversed. Accordingly, Applicants respectfully submit that all claims are now in condition for allowance. Early and favorable indication of allowance is courteously solicited.

The Examiner is invited to telephone the undersigned, Applicant's attorney of record, to facilitate advancement of the present application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

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